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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/824,092	04/03/2001	Yoshitaka Nagao	35.C15264	9326
5514	7590	08/05/2004	EXAMINER	
FITZPATRICK CELLA HARPER & SCINTO			COLE, ELIZABETH M	
30 ROCKEFELLER PLAZA			ART UNIT	
NEW YORK, NY 10112			PAPER NUMBER	

1771

DATE MAILED: 08/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/824,092

Applicant(s)

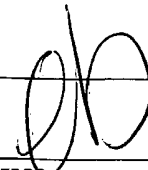
NAGAO ET AL.

Examiner

Elizabeth M. Cole

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3, 5-7 and 9-28 is/are pending in the application.
- 4a) Of the above claim(s) 23-27 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5-7, 9-22, 28 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

1. Claims 1-3, 5-7,9,12-16, 18-22, 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over GB 1,358,345 in view of Michaud, U.S. Patent No. 4,936,070. GB '345 discloses a roofing material comprising a fiber glass sheet which corresponds to the fire resistant material and layer which may be coated on one face with an adhesive which corresponds to the waterproofing layer. The adhesive layer may bond a facing material such as a film layer or other moisture impervious materials. The adhesive may comprise a polyvinyl material. Polyvinyls are known to be thermoplastics. The material may be transported in roll form. See p. 3, line 98 – page 4, line 95 and page 4, lines 122-126 and figure 6. Since the material may be formed into a roll, it is flexible. GB '345 differs from the claimed invention because GB '345 does not teach applying a filler or resin coating on a portion of the side of the roofing material which will be adhered to the roof. Michaud teaches that the edge portions of roofing materials which will be overlapped in use may be coated with a resin such as an adhesive. See col. 3, lines 27-29. Michaud also teaches that the fiberglass material may have an adhesive coating applied to the underside to adhere it to the roof to which it is applied. It would have been obvious to have applied an adhesive to the edge portions of the material of GB '345. One of ordinary skill in the art would have been motivated to apply an adhesive to the edge portion of GB '345 by the teaching of Michaud that overlapping the edges with the adhesive coating allows for improved waterproofing of the roof. See col. 3, lines 50-52. It further would have been obvious to have applied an adhesive coating to the material of GB '345 as taught by Michaud in order to bond the roofing to the roof substrate. See col. 3, lines 39-42 of Michaud.

2. Claims 10-11, 16-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over GB '345 in view of Michaud as applied to claims 4-7,9,12-13, 18-20 above, and further in view of DE 29,801,546, (abstract). Neither GB '345 nor Michaud teach employing metal protective layer. DE '546 teaches that metal foil layers can be used as the protective layer for fibrous roofing materials. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have employed a metal foil layer as taught by DE '546 instead of or in addition to the polymer films disclosed in GB '345. One of ordinary skill in the art would have been motivated to employ a metal foil layer because DE '546 teaches that the metal foil layers also provide barrier properties to the roofing material.
3. Applicant's arguments filed 5/24/04 have been fully considered but they are not persuasive. Applicant argues that Michaud does not teach coating a water absorption preventing layer on the second side of the fibrous layer because the extended tab in Michaud does not contact the second side of the fibers. However, the extended tab in Michaud faces the second side of the fibrous layer. Additionally, Michaud teaches applying an adhesive to the second side in order to bond the second side to the roof structure. Therefore, the rejection is maintained.
4. Applicant's amendment reciting that the flame resistive fibers are in the form of a sheet has overcome the 112 2nd paragraph rejection.
5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after

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the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elizabeth M. Cole whose telephone number is (571) 272-1475. The examiner may be reached between 6:30 AM and 6:00 PM Monday through Wednesday, and 6:30 AM and 2 PM on Thursday.

Mr. Terrel Morris, the examiner's supervisor, may be reached at (571) 272-1478.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

The fax number for all official faxes is (703) 872-9306.



Elizabeth M. Cole
Primary Examiner
Art Unit 1771

e.m.c